

ESTTA Tracking number: **ESTTA498879**

Filing date: **10/09/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91206545
Party	Defendant Douglas Kohlberg French
Correspondence Address	SHERYL DE LUCA NIXON & VANDERHYE PC 901 N GLEBE RD FL 11 ARLINGTON, VA 22203-1808 UNITED STATES nixonptomail@nixonvan.com
Submission	Other Motions/Papers
Filer's Name	Sheryl De Luca
Filer's e-mail	nixonptomail@nixonvan.com, sld@nixonvan.com
Signature	/Sheryl De Luca/
Date	10/09/2012
Attachments	5120-3 Reply.pdf (13 pages)(1355196 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

5120-3

RODRIGORODRIGUEZ)	
)	
Opposer,)	
)	Opposition No. 91206545
v.)	Application No. 78/586,170
)	Mark: SCORPION & design
FRENCH DOUGLAS, KOHLBERG)	
Applicant.)	

Box TTAB NO FEE

Commissioner for Trademarks
P.O. Box 1451
Arlington, Virginia 22313-1451

**REPLY IN SUPPORT OF APPLICANT'S
MOTION TO DISMISS
FOR INSUFFICIENT SERVICE**

This is in reply to the paper filed by Opposer titled "Notice to Contest the Motion to Dismiss for Insufficient Service," dated September 18, 2012 ("Opposition Brief"), and in support of Applicant's Motion to Dismiss. For the additional reasons stated herein, this Opposition must be dismissed.

In Mr. Rodriguez' Opposition Brief, he claims that he sent Applicant ("French Douglas, Kohlberg") a copy of his Notice of Opposition on August 14, 2012 by First Class Mail at the address: Apartado 252, Oaxaca, OH 44017, U.S.A. Opposer's Opposition Brief includes an attachment of what he alleges to have mailed to Applicant, which consists of a letter and a one page documents titled "Notice of Opposition."

There are several errors with Opposer's Opposition Brief and attachment thereto, which (1) cause the Opposition Brief itself to be insufficient for consideration by

the Board and (2) in any case, does not cure the insufficiency of process raised with Applicant's Motion to Dismiss.

First, with the Opposition Brief dated September 18, 2012, Opposer did not include any proof of service. The elements that need to be included for proof of services are: a statement signed by the filing party, or by its attorney or other authorized representative, clearly stating the date and manner in which service was made and the name of each party or person upon whom service was made, and the address. The statement must appear on, or be securely attached to, the document being filed. If the statement is on a separate sheet attached to the filing, it should clearly identify the submission and proceeding to which it relates. Such proof of service is generally required before the Board will consider a filing. See TBMP Sections 113.02 and 113.03 and 37 CFR § 2.119(a).

Mr. Rodriguez' opposition does not include the required elements for a certificate of service. Thus, it should not be considered by the Board. However, in the event, the Board considers it anyway, Applicant submits the following points.

The address that Opposer indicates that he sent Applicant his Notice of Opposition on August 14, 2012 is incorrect. It apparently came from the USPTO's electronic record of Applicant's application. However, the electronic record is noticeably incorrect.¹ The prosecution history data of the opposed application, Application Serial No. 78/586,170, shows that Applicant correctly submitted an address change in March 2007, to "Apartado 252 Oaxaca, Mexico 68000," (see Exhibit A hereto). It appears that the USPTO amendment and mail processing staff inadvertently entered the address

¹ Applicant just became aware that the record is not correct.

change in the electronic records as Apartado 252, Oaxaca, OH 44017, which is not a real address. See Exhibit B hereto (USPTO internal record data). Thus, if service was allegedly made on August 14, 2012, Opposer served the incorrect address for Applicant. Presumably, if Opposer mailed a notice of opposition to that address on August 14, 2012, it would have come back to Opposer as “undeliverable” because it is not a real address.

Moreover, even if Opposer mailed Applicant the letter and attachment on August 14, 2012, he failed to include the TTAB's electronic ESTTA-generated filing form with his mailing, which is considered a part of the Notice of Opposition. TBMP 306.01. In addition, what he claimed was attached to his August 14, 2012 letter to Applicant is simply not the same thing as what was filed with the TTAB on August 14, 2012 (not only is the ESTTA filing form missing, but, the attachment that was also electronically filed is missing from his August 14, 2012 letter to Mr. French). So, his “service” of the Notice of Opposition was clearly improper.

Further, even if Opposer mailed Applicant the letter and attachment on August 14, 2012 that was attached to the Opposition Brief, that form of service does not correspond to the method of service he indicated on the Notice of Opposition filing form (which was certified to be by facsimile or email by agreement). The evidence does not add up that Opposer made any actual proper service to Applicant.

Applicant confirms that he did not receive the correspondence from Opposer attached to the Opposition Brief. See Exhibit C, French Decl. ¶ 2 of October 5, 2012.

In view of the above, this opposition should not have been accorded a filing date and should be dismissed.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: Sheryl De Luca
Sheryl De Luca


901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100

CERTIFICATE OF SERVICE

I hereby certify that on October 9, 2012, the foregoing **REPLY IN SUPPORT OF APPLICANT'S MOTION TO DISMISS FOR INSUFFICIENT SERVICE** was served on Opposer via first-class mail to:

Rodrigo Rodriguez Islas
395 Sawdust Rd 2192
Spring, Texas 77380

NIXON & VANDERHYE, PC

By: 
Sheryl De Luca
901 North Glebe Rd.
11th Floor
Arlington, VA 22208-1808
Phone: 703-816-4022
Fax: 703-816-4100

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	78586170
LAW OFFICE ASSIGNED	LAW OFFICE 102
MARK SECTION (no change)	
OWNER SECTION (current)	
NAME	French Douglas, Kohlberg
STREET	101 Seminary Street
CITY	Berea
STATE	Ohio
ZIP/POSTAL CODE	44017
COUNTRY	US
PHONE	440-826-1616
FAX	440-826-1617
OWNER SECTION (proposed)	
NAME	French Douglas, Kohlberg
STREET	Apartado 252
CITY	Oaxaca
ZIP/POSTAL CODE	68000
COUNTRY	Mexico
PHONE	440-826-1616
FAX	440-826-1617
EMAIL	rick@airlawyer.com
LEGAL ENTITY SECTION (current)	
TYPE	INDIVIDUAL
COUNTRY OF CITIZENSHIP	US

Exhibit A

LEGAL ENTITY SECTION (proposed)

TYPE	INDIVIDUAL
COUNTRY OF CITIZENSHIP	United States

SIGNATURE SECTION

RESPONSE SIGNATURE	/Richard H. French, Jr./
SIGNATORY'S NAME	Richard H. French, Jr.
SIGNATORY'S POSITION	Attorney of Record
DATE SIGNED	03/01/2007
AUTHORIZED SIGNATORY	YES

FILING INFORMATION SECTION

SUBMIT DATE	Thu Mar 01 16:55:01 EST 2007
TEAS STAMP	USPTO/ROA-68.71.107.234-2 0070301165501888038-78586 170-3603a703edbfcb4bcf2e9 bca4735f96ca5-N/A-N/A-200 70301164754942916

PTO Form 1957 (Rev 9/2005)
OMB No. 0651-9050 (Exp. 04/2009)

Response to Office Action
To the Commissioner for Trademarks:

Application serial no. **78586170** has been amended as follows:

Procedural Matters/Informalities**Applicant proposes to amend the following:**

Original: Kohlberg French Douglas, , a citizen of US, having an address of 101 Seminary Street Berea, Ohio US 44017, whose phone number is 440-826-1616, whose phone number is 440-826-1617.

Proposed: Kohlberg French Douglas, a citizen of United States, having an address of Apartado 252 Oaxaca, Mexico 68000, whose e-mail address is rick@airlawyer.com, whose phone number is 440-826-1616 and whose fax number is 440-826-1617.

Response Signature

Signature: /Richard H. French, Jr./ Date: 03/01/2007

Signatory's Name: Richard H. French, Jr.

Signatory's Position: Attorney of Record

Serial Number: 78586170

Internet Transmission Date: Thu Mar 01 16:55:01 EST 2007

TEAS Stamp: USPTO/ROA-68.71.107.234-2007030116550188

8038-78586170-3603a703edbfcb4bcf2e9bca47

35f96ca5-N/A-N/A-20070301164754942916

Trademark Snap Shot Amendment & Mail Processing Stylesheet
(Table presents the data on Amendment & Mail Processing Complete)

OVERVIEW

SERIAL NUMBER	78586170	FILING DATE	03/13/2005
REG NUMBER	0000000	REG DATE	N/A
REGISTER	PRINCIPAL	MARK TYPE	TRADEMARK
INTL REG #	N/A	INTL REG DATE	N/A
TM ATTORNEY	OSBORNE, STANLEY I	L.O. ASSIGNED	102

PUB INFORMATION

RUN DATE	03/03/2007
PUB DATE	N/A
STATUS	661-RESPONSE AFTER NON-FINAL-ACTION-ENTERED
STATUS DATE	03/02/2007
LITERAL MARK ELEMENT	SCORPION

DATE ABANDONED	N/A	DATE CANCELLED	N/A
SECTION 2F	NO	SECTION 2F IN PART	YES
SECTION 8	NO	SECTION 8 IN PART	NO
SECTION 15	NO	REPUB 12C	N/A
RENEWAL FILED	NO	RENEWAL DATE	N/A
DATE AMEND REG	N/A		

FILING BASIS

FILED BASIS		CURRENT BASIS		AMENDED BASIS	
1 (a)	YES	1 (a)	YES	1 (a)	NO
1 (b)	NO	1 (b)	NO	1 (b)	NO
44D	NO	44D	NO	44D	NO
44E	YES	44E	YES	44E	NO
66A	NO	66A	NO		
NO BASIS	NO	NO BASIS	NO		

MARK DATA

STANDARD CHARACTER MARK	NO
LITERAL MARK ELEMENT	SCORPION

Exhibit B

MARK DRAWING CODE	3-AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/LETTER(S)/NUMBER(S)
COLOR DRAWING FLAG	YES

CURRENT OWNER INFORMATION

PARTY TYPE	10-ORIGINAL APPLICANT
NAME	French Douglas, Kohlberg
ADDRESS	Apartado 252 Oaxaca, OH 44017
ENTITY	01-INDIVIDUAL
CITIZENSHIP	United States of America

GOODS AND SERVICES

INTERNATIONAL CLASS	033
DESCRIPTION TEXT	Alcoholic beverages, namely, Distilled Spirits, in International Class 33

GOODS AND SERVICES CLASSIFICATION

INTERNATIONAL CLASS	033	FIRST USE DATE	04/02/2001	FIRST USE IN COMMERCE DATE	06/01/2001	CLASS STATUS	6-ACTIVE
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MISCELLANEOUS INFORMATION/STATEMENTS

CHANGE IN REGISTRATION	NO
DESCRIPTION OF MARK	"The mark consists of the word "SCORPION"."
SECT 2(F) LIMITATION STMT	""SCORPION" has become distinctive of the goods/services through the applicant's substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement."

FOREIGN INFORMATION

PRIORITY CLAIMED	N/A
APPLICATION NO.	N/A
APPLICATION FILING DATE	N/A
FOREIGN REG NO.	630341
FOREIGN REG DATE	05/28/2004
FOREIGN RNWL NUM	N/A
DATE OF FOREIGN RNWL	N/A
FOREIGN EXPIRATION	05/26/2009

FOREIGN RNWL EXPIRATION

N/A

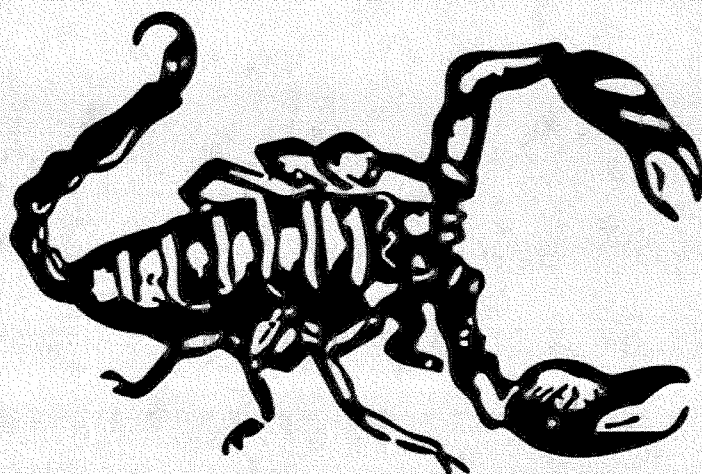
PROSECUTION HISTORY

DATE	ENT CD	ENT TYPE	DESCRIPTION	ENT NUM
03/02/2007	TEME	I	TEAS/EMAIL CORRESPONDENCE ENTERED	019
03/01/2007	CRFA	I	CORRESPONDENCE RECEIVED IN LAW OFFICE	018
03/01/2007	TROA	I	TEAS RESPONSE TO OFFICE ACTION RECEIVED	017
02/01/2007	RCSC	S	REPORT COMPLETED SUSPENSION CHECK CASE STILL SUSPENDED	016
08/01/2006	GNSL	S	LETTER OF SUSPENSION E-MAILED	015
08/01/2006	CNSL	R	SUSPENSION LETTER WRITTEN	014
06/19/2006	TEME	I	TEAS/EMAIL CORRESPONDENCE ENTERED	013
06/11/2006	CRFA	I	CORRESPONDENCE RECEIVED IN LAW OFFICE	012
06/11/2006	TROA	I	TEAS RESPONSE TO OFFICE ACTION RECEIVED	011
06/01/2006	GNSL	S	LETTER OF SUSPENSION E-MAILED	010
06/01/2006	CNSL	R	SUSPENSION LETTER WRITTEN	009
03/29/2006	TEME	I	TEAS/EMAIL CORRESPONDENCE ENTERED	008
03/19/2006	CRFA	I	CORRESPONDENCE RECEIVED IN LAW OFFICE	007
03/19/2006	TROA	I	TEAS RESPONSE TO OFFICE ACTION RECEIVED	006
03/19/2006	TCCA	I	TEAS CHANGE OF CORRESPONDENCE RECEIVED	005
09/30/2005	GNRT	F	NON-FINAL ACTION E-MAILED	004
09/30/2005	CNRT	R	NON-FINAL ACTION WRITTEN	003
09/29/2005	DOCK	D	ASSIGNED TO EXAMINER	002
03/18/2005	NWAP	I	NEW APPLICATION ENTERED IN TRAM	001

CURRENT CORRESPONDENCE INFORMATION

ATTORNEY	NONE
CORRESPONDENCE ADDRESS	Richard H. French, Jr. The French Firm Co., L.P.A. 101 Seminary Street Berea OH 44017
DOMESTIC REPRESENTATIVE	NONE

Scorpion



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

5120-3

RODRIGORODRIGUEZ

Opposer,

v.

FRENCH DOUGLAS, KOHLBERG
Applicant.

Opposition No. 91206545

DECLARATION OF DOUGLAS KOHLBERG FRENCH

I, Douglas Kohlberg French, declare as follows:

1. That I am the Applicant and am authorized to execute this declaration.
2. To date, I did not receive the letter dated August 14, 2012 and attachment titled "Notice of Opposition," which is attached to Opposer's "Notice to Contest the Motion to Dismiss for Insufficient Service" filing at the TTAB."
3. I just became aware that the address change I submitted in March 2007 appears to have been inadvertently misidentified in the USPTO records as Oaxaca, OH 44017, it should have been changed to Apartado 252 Oaxaca, Mexico 68000, as indicated in my address change.

I declare under penalty of perjury that the foregoing is true and correct to the best of my knowledge, information and belief.

Executed on

Oct 5, 2012



Exhibit C